# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/075,265 | 02/15/2002 | Yi Ming Liao | P67621US0 | 9111 |

| 136 | 7590 | 03/14/2005 | EXAMINER |
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| ART UNIT | PAPER NUMBER |
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| 2122 | |

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>15 February 2002</u>.

2a)☐ This action is **FINAL**.    2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-14</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-14</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.      Claims 1-14 are pending and have been examined.  The priority date considered for the

application is February 15, 2002.

### *Claim Objections*

2.      Claim 11 is objected to because of the following informalities:  The term "decision-

makings" in line 2 could be replaced with --decision-making--.  Similarly, "an predicted" in line

3 should read --a predicted--, and "a economic" in line 7 should read --an economic--.  The

language "between predicted" in line 5 could be replaced with --between the predicted--.

Appropriate correction is required.  Applicant is respectfully asked to find and correct other such

grammatical and idiomatic informalities in the claims.

### *Claim Rejections - 35 USC § 112*

3.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

4.      Claims 2-6 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

Applicant regards as the invention.

        With respect to claim 2, the language of the preamble renders the claim indefinite.  The

claim recites, "The development evaluation system of claim 1," yet claim 1 recites a method.

Furthermore, the lengthy recitation in the preamble that begins, "the step of for analyzing," is

generally unclear. The claim must additionally end with a period, as described in MPEP § 608.01(m).

With respect to claims 3 and 5, the language of the preamble renders the claims indefinite. The claims recite, "The development evaluation system of claim 1" and "of claim 4," respectively, yet claims 1 and 4 both recite a method.

With respect to claim 4, the language of the preamble renders the claim indefinite. The recitation, "wherein operating the applied development software, which further comprises the steps of," is ambiguous. Furthermore, there is insufficient antecedent basis for "the input recognition module" in the claim. Claim 1 does not recite an input recognition module.

With respect to claim 6, the language of the preamble, "A development evaluation system applies for managing," is indefinite. Likewise, the recitation, "a resource statistics module, which counts the operating conditions ... and integrating statistic outputs," is also unclear. The term "integrating" should perhaps read --integrates--.

With respect to claim 12, the claim recites the limitation, "wherein after analyzing the economic efficiency." There is insufficient antecedent basis for this limitation in the claim. Claim 11 does not positively recite the step of analyzing the economic efficiency. Furthermore, the language "it further includes" is unclear because the term "it" may refer to "the development evaluation method" or to "the economic efficiency."

With respect to claim 13, the claim recites the limitation, "wherein the evaluation

function is the algorithm for calculating the economic efficiency." There is insufficient

antecedent basis for this limitation in the claim. Claim 11 does not recite an algorithm.

### Claim Rejections - 35 USC § 101

5.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

6.      Claims 11-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

The claims are directed to abstract ideas that are not expressly limited to a technological

art, environment or machine. For example, the steps of the recited method may be performed

merely as a mental exercise without the use of computer hardware, and therefore would not

produce a concrete and tangible result. Such abstract ideas do not constitute a statutory process,

machine, manufacture or composition of matter. See MPEP § 2106(IV)(B)(1). A simple

remedy, for example, would be to include a term such as "computer-implemented" in the

language of the preamble, which would then convey a tangible embodiment.

### Claim Rejections - 35 USC § 102

7.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.      Claims 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub. No. 2002/0069102 to Vellante et al. ("Vellante").

With respect to claim 11, Vellante discloses a development evaluation method aims at evaluating the efficiency of developed software as the base of decision-makings assistance (see, for example, the abstract), which comprises the steps of:

(a) obtaining an predicted requirement report (see, for example, page 6, paragraph 76, lines 12-18, which shows a report of the potential or predicted value) and an operating conditions report (see, for example, page 6, paragraph 77, which shows a report of the operating costs or conditions);

(b) comparing the differences between predicted requirement report and the operating conditions report (see, for example, page 6, paragraph 76, lines 1-12, which shows comparing and finding the difference between the potential or predicted value and the operating costs or conditions); and

(c) calculating a economic efficiency via an evaluation function (see, for example, page 8, paragraph 99, which shows calculating a net business value or economic efficiency).

With respect to claim 12, the rejection of claim 11 is incorporated, and Vellante also discloses the limitation wherein after analyzing the economic efficiency, it further includes an outputted evaluation report (see, for example, page 4, paragraph 62, which shows an output evaluation report).

With respect to claim 13, the rejection of claim 11 is incorporated, and Vellante also discloses the limitation wherein the evaluation function is the algorithm for calculating the economic efficiency (see, for example, FIG. 1 and page 4, paragraph 63, which shows the algorithm for calculating the net business value or economic efficiency).

With respect to claim 14, the rejection of claim 11 is incorporated, and Vellante also discloses the limitation wherein the evaluation function further includes an evaluation foundation for feedback and correction (see, for example, page 12, paragraph 143, which shows that the evaluation function includes terms for feedback and correction).

## *Claim Rejections - 35 USC § 103*

9.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.      Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,499,340 to Barritz ("Barritz") in view of U.S. Pat. No. 5,881,225 to Worth ("Worth").

With respect to claim 1, Barritz discloses a development evaluation method applies an evaluation of applied development software for an enterprise to evaluate economic efficiency of the applied development software (see, for example, the abstract, and column 2, line 65 to column 3, line 9, which shows evaluating economic efficiency), which comprises the steps of:

(a) establishing the applied development software for supporting operations of at least

one department (see, for example, column 4, lines 28-31, which shows establishing the software

for evaluation, and column 5, lines 38-46, which shows that the software includes applied

development software).

Although Barritz does not expressly disclose a department, any such applied development

software as disclosed by Barritz inherently supports operations of at least one department;

otherwise, the software would have no use.

Nonetheless, Worth discloses an authorization system for determining whether to grant a

user access to an application (see, for example, column 3, lines 2-16). Worth further discloses

that access to the application may be determined based on the group and role with which the

application is used (see, for example, column 5, lines 10-14). The group corresponds to the

department of the user within the organization (see, for example, column 5, lines 15-25).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to supplement the method of Barritz with the authorization features taught by Worth,

so as to grant or deny access to the applied development software based on the user and the

user's department. The combination would have been obvious because one of ordinary skill in

the art would have been motivated to use this information to comply with software licenses, such

as disclosed by Barritz (see, for example, column 10, lines 23-27).

Therefore, in view of Worth, the applied development software of Barritz is for

supporting operations of at least one department.

Barritz also discloses:

(b) establishing a development evaluation system for analyzing economic efficiency of the applied development software (see, for example, column 6, lines 32-35, which shows establishing a monitor or evaluation system, and column 2, line 65 to column 3, line 9, which shows evaluating economic efficiency), and confirming, recording, and counting a user's operating condition of the applied development software (see, for example, column 9, lines 28-35, which shows confirming, recording and counting operating conditions of the software), then using the user's operating condition to compare and evaluate values of the applied development software and output statistic reports (see, for example, column 9, lines 47-67, which shows comparing and evaluating the operating conditions of the software to produce reports).

With respect to claim 2, the rejection of claim 1 is incorporated, and Barritz also discloses the steps of:

(a) establishing an input recognition module for confirming the ID and department of a user operating the applied development software (see, for example, column 10, lines 1-6, which shows confirming the identity of the user);

(b) establishing a process recording module for recording the user's operating condition of the applied development software (see, for example, column 6, lines 36-42, which shows recording the operating conditions of the software);

(c) establishing a resource statistics module for counting the operating conditions of the process recording module, and categorizing the output statistic results (see, for example, column 8, lines 41-43, which shows counting and categorizing the results);

(d) establishing an evaluation comparison module for comparing and evaluating the integrated statistic results of the resource statistics module (see, for example, column 8, lines 46-48, which shows comparing and evaluating the results); and

(e) establishing a central control module for communicating and monitoring the development evaluation system and operations of respective modules of the system (see, for example, column 4, lines 9-11, which shows an operating system or central control module).

With respect to claim 3, the rejection of claim 1 is incorporated, and Barritz further discloses the limitation wherein the applied development software is assistant software required on work by users (see, for example, column 10, lines 56-65, which shows that the software may be required on work by users).

With respect to claim 4, the rejection of claim 1 is incorporated, and Barritz further discloses the steps of:

(a) confirming the user's ID via the input recognition module (see, for example, column 10, lines 1-6, which shows confirming the identity of the user); and

(b) permitting to execute the applied development software (see, for example, column 10, lines 37-40, which shows permitting or denying execution of the software).

With respect to claim 5, the rejection of claim 4 is incorporated, and Barritz further discloses the limitation wherein the input recognition module can be operated for confirmation via the network connection (see, for example, column 10, line 66 to column 11, line 11, which shows operating over a network connection).

With respect to claim 6, Barritz discloses a development evaluation system applies for

managing a developed applied development software to record and evaluate the operating

conditions of the applied development software (see, for example, the abstract), which

comprises:

(a) an input recognition module, which confirms ID of a user, who is operating the

applied development software (see, for example, column 10, lines 1-6, which shows confirming

the identity of the user operating the software, and column 5, lines 38-46, which shows that the

software includes applied development software).

Although Barritz discloses confirming the identity of the computer (see, for example,

column 10, lines 44-48), Barritz does not expressly disclose confirming a department code.

However, Worth discloses an authorization system for determining whether to grant a

user access to an application (see, for example, column 3, lines 2-16). Worth further discloses

that access to the application may be determined based on the group and role with which the

application is used (see, for example, column 5, lines 10-14). The group corresponds to the

department of the user within the organization (see, for example, column 5, lines 15-25).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to supplement the method of Barritz with the authorization features taught by Worth,

so as to grant or deny access to the applied development software based on the user and the

user's department. The combination would have been obvious because one of ordinary skill in

the art would have been motivated to use this information to comply with software licenses, such

as disclosed by Barritz (see, for example, column 10, lines 23-27).

Therefore, in view of Worth, the input recognition module of Barritz also confirms the department code of the user.

(b) a process recording module, which records the user's operating condition of the applied development software (see, for example, column 6, lines 32-42, which shows a monitor for recording the operating conditions of the software);

(c) a resource statistics module, which counts the operating conditions recorded by the process recording module and integrating statistic outputs (see, for example, column 9, lines 28-35, which shows counting the operating conditions of the software);

(d) an evaluation and comparison module, which compares the differences between a file integrated by the resource statistics module and an predicted requirement report proposed by an applicant of the applied development software, and evaluates an economic efficiency of the developed software (see, for example, column 9, lines 47-67, which shows comparing the operating conditions of the software with provided configuration information to produce reports; column 10, lines 18-22, which shows configuring the requirements; and column 2, line 65 to column 3, line 9, which shows evaluating economic efficiency); and

(e) a central control module, which communicates and monitors the development evaluation system and operations of respective modules of the system (see, for example, column 4, lines 9-11, which shows an operating system or central control module).

With respect to claim 7, the rejection of claim 6 is incorporated, and Barritz further discloses the limitation wherein the input recognition module is able to recognize, via the network, ID and department of the user, who is entering the applied development software (see, for example, column 10, line 66 to column 11, line 11, which shows operating over a network).

With respect to claim 8, the rejection of claim 6 is incorporated, and Barritz further

discloses the limitation wherein the process recording module is able to record the user's

operating condition via the network (see, for example, column 10, line 66 to column 11, line 11,

which shows operating over a network).

With respect to claim 9, the rejection of claim 6 is incorporated, and Barritz further

discloses the limitation wherein the resource statistics module is able to integrate and output the

statistic data recorded by the process recording module via the network (see, for example,

column 10, line 66 to column 11, line 11, which shows operating over a network).

With respect to claim 10, the rejection of claim 6 is incorporated, and Barritz further

discloses the limitation wherein the predicted requirement report is a variation demand proposed

by the applicant before establishing the applied development software (see, for example, column

10, lines 18-22, which shows that the requirements are specifications or variations proposed

before using the software).

### *Conclusion*

11.    The prior art made of record and not relied upon is considered pertinent to Applicant's

disclosure.  U.S. Pat. No. 6,086,618 to Al-Hilali et al. discloses a method and computer program

product for estimating total resource usage requirements of a server application in a hypothetical

user configuration.

12.    Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707.

The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.
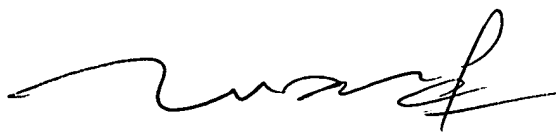
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


                                            MY          Michael J. Yigdall
                                                        Examiner
                                                        Art Unit 2122

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                                    SUPERVISORY PATENT EXAMINER